

Docket No. F-8241

Ser. No. 10/509,265

REMARKS

Claims 9-18 remain pending in this application and are rejected. Claims 1-8 are previously cancelled.

Claims 9-18 are rejected under 35 U.S.C. §103(a) as obvious over Miehle et al. (U.S. Pat. No. 6,247,812) in view of the Matsugu et al. (U.S. Pat. No. 5,625,408). More specifically, the Office Action states that Miehle teaches all the elements recited in the claims except for the control unit for controlling an illuminating device and an image generating device which is disclosed in Matsugu. In other words, the rejection characterizes the method recited in the claims as simply the combining of prior art elements according to known methods to yield predictable results.

MPEP §2143 states that when rejecting a claim based on the rationale that the recited structure is simply "combining prior art elements according to known methods to yield predictable results" there must be a "finding that the prior art included each element." In addition, there must be a finding that "each element merely performs the same function as it does separately." Furthermore, "if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." See MPEP §2143.01 citing *In re*

Docket No. F-8241

Ser. No. 10/509,265

Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. See *In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974).

The applicants respectfully traverse the rejection because the prior art fails to include each step as recited in the claims. The obviousness rejection of the claims with reference to the cited art does not consider the details of the steps recited.

In regard to claims 9 and 17, the cited art does not disclose a step of "evaluating *quality of the images*." The analysis in the Office Action conflates the evaluating step with the comparing step and does not consider what is being evaluated. In *Miehle*, two sets of data are used to try and identify "a defect or condition of the biological structure." See *Miehle* Abstract. However, there is nothing disclosing or even suggesting that the data generated in the *Miehle* process is evaluated *itself* in order to ensure its quality. *Miehle* does not even discuss any concerns with the accuracy or reliability of any of the test data generated. Thus, a *prima facie* case of obviousness has not been established because the prior art does not disclose a step wherein the quality of the generated images is evaluated.

Docket No. F-8241

Ser. No. 10/509,265

In regard to claims 9 and 17, the cited art does not disclose a step of "controlling .. the camera and/or the illumination unit ..for further evaluating quality of the images ..." The analysis in the Office Action does not consider the criteria or variables for controlling the camera. Matsugu is cited by the Office Action for disclosing controlling the position of cameras. However, Matsugu's method is directed to recording a stereoscopic or three dimensional image. In Matsugu, the lens positions are controlled by a "discriminating means" (19) which sends information to a "configuration controlling means" (17). The discriminating means (19) "discriminates an area where corresponding points of right and left images are present, and an image area taken by only the right or left eye camera on the basis of a parallax value." See Matsugu Col. 9 lines 12-15. Then the configuration controlling means (17) moves the cameras "so as to change visible area size to the both eyes" based upon the data supplied by the discriminating means (19) to create a stereoscopic image. See Matsugu Col. 9 line 22. In other words, the controlling of the camera positions in Matsugu is based upon very specific parameters to accomplish a task unrelated to further evaluation of the quality of images. Matsugu requires two cameras and a discriminating means and controls the cameras to create a stereoscopic image. There is nothing disclosing or even suggesting in Matsugu that quality of the images or degree of certitude of classification of images is used in controlling the positioning of the cameras. Therefore, combining Matsugu's controlling step with Michle's method would

Docket No. F-8241

Ser. No. 10/509,265

change the functionality of the controlling step and render it non-functional for its intended purpose of recording stereoscopic images. Furthermore, Matsugu has no discussion whatsoever on illumination or lighting and, therefore, certainly does not even suggest controlling the positioning of an illumination unit for any reason. Thus, a *prima facie* case of obviousness has not been established because the prior art does not disclose a step of controlling a camera or illumination unit for generating a new image to be evaluated and compared.

In regard to claim 14, the cited art does not disclose controlling of a laser beam by a control unit. Miehle specifically states that their system “allows the *surgeon* to focus the laser device.” (emphasis added) See Miehle col. 13 lines 29-30. Furthermore, although Miehle discloses that “the illumination device 404 generates a relatively low intensity illumination light,” there is no suggestion that the intensity is varied at all, let alone carefully controlled by a control unit. *Id.* col. 12 lines 28-29. Thus, a *prima facie* case of obviousness has not been established because the prior art does not disclose a laser under control of a control unit or whose intensity is varied or controlled.

In regard to claims 17 and 18, the cited art does not disclose comparing images with image patterns corresponding to one or more diseases. In particular, the disclosure of a memory element in Miehle’s device to record the image of the

Docket No. F-8241

Ser. No. 10/509,265

fundus does not render the claims obvious. A memory element is inherent in any device for recording data. However, the claims at issue recite a method and it is the method that distinguishes the claims over Miehle. The Examiner states that Miehle discloses *correlating* combined data to a specific disease. However, the "combined data" that Miehle is referring to is disparate data of the *same patient*. As Miehle states at the beginning of the paragraph cited in the Office Action, "[s]ome embodiments of the invention could automatically compare one type of data to at least one other disparate type of data, and *combine the data* so that the disparate data can be presented together." See Miehle col. 4 line 10-13 (emphasis added). Only in regard to targeting treatment does Miehle disclose using similar data and only with regard to data generated from tests on the same patient. *Id.* col. 5 line 22-27. In other words, Miehle only discloses using patterns between data from different types of tests to find a *correlating* pattern that may be determinative of a disease. Thus, a *prima facie* case of obviousness has not been established because the prior art does not disclose comparing images with image patterns corresponding to one or more diseases.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Docket No. F-8241

Ser. No. 10/509,265

The response to the arguments section of the Office Action gives some indication that if a limitation precluding "comparing two image patterns of the same person" were added to claims 17 and 18 they may be deemed allowable. Applicants reiterate their contention that claims 17 and 18 are patentable in their current form. However, applicants would be willing to amend claim 17 by adding a limitation such as "comparing the at least one image with existing image data not of the ocular fundus being examined which are characteristic for at least one disease to determine..."

Also, in regard to claim 14, applicants reiterate their contention that it is patentable in its current form.. However, applicants would be willing to consider deletion of references to the scanning area and focus of the laser beam, if Examiner believes such an amendment would put the claim in proper form for allowance. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Applicants respectfully request a two month extension of time for responding to the Office Action. The fee of \$460 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

11/07/2007 PCHUMP 00000036 10509265

01 FC:1252

460.00 0P

Docket No. F-8241

Ser. No. 10/509,265

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg *By M. Zev Levoritz*
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

and,

By M. Zev Levoritz
M. Zev Levoritz
Reg. No. 50,151
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Form PTO-2038.